

REMARKS

Claims 1 to 17 are now pending.

The Applicants thank the Examiner for acknowledging that certified copies of the priority documents have been received.

The Applicants respectfully request that the Examiner acknowledge in the next Office communication whether the Drawings are accepted.

With respect to paragraph three (3) of the Office Action, while the objections may not be agreed with, to facilitate matters, claims 7, 8, 13, and 14 have been rewritten, to facilitate matters, to include the features of their respective base claims. Still further claims 9 and 15 now respectively depend from claims 8 and 14, as presented. Accordingly, claims 7 to 9 and 13 to 15 are allowable. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph two (2), claims 1 to 6, 10 to 12, 16 and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by Wang, U.S. Patent No. 6,298,718.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claims 1 and 17 have been rewritten, to facilitate matters. Essentially, these are in the same form except that each of claims 1 and 17 now include the features of claims 2 and 3. Claims 2 and 3 have been rewritten to conform to claim 1 as presented.

In particular, each of independent claims 1 and 17 now provide that the measured actual pressure ratio is compared with a desired setpoint pressure ratio to be set or with a modeled actual pressure ratio, which are features found in original claims 2 and 3.

The “Wang” reference refers to a turbocharger-compressor diagnostic system, in which an abnormal operation of the turbocharger-compressor is detected. For this purpose, data are read out from a plurality of sensors. In the process, first a series of plausibility tests are performed on the basis of the sensor data. These tests are used in deciding whether the data provided by the sensors are precise or faulty. If a particular sensor does not pass the plausibility test, an error signal is generated. If all sensors pass the plausibility tests, however, then the performance data of the compressor are compared to a characteristics map for the compressor operation. If the compressor operation falls into either the surge or choke region of the characteristics map, then a signal is generated indicating an abnormal performance. (See Abstract).

To test the abnormal operation of the compressor, a test is performed as to whether in a current air mass flow the associated compressor pressure ratio falls into the shaded region indicated in Figure 8. Outside of this region are the surge and choke regions and an abnormal operation is detected which has the consequence that the engine control must change the engine operation parameters in such a way that the compressor again operates in the shaded region of Figure 8 (“Wang” reference, col. 3, lines 16 to 23; and col. 9, lines 30 to 38).

Thus, to diagnose an abnormal operation of the compressor for the subject matter of the “Wang” reference, the current compressor pressure ratio is compared with the two boundary lines 120, 121 of Figure 8. Outside of the shaded region represented by the boundary lines 120 and 121 in Figure 8, the compressor itself does not operate in a faulty manner, but merely in an undesired operating range of the internal combustion engine, in which the resulting compressor performance has the consequence of either surging or choking the compressor and is thus undesired.

In contrast, with the claimed subject matter of claims 1 and 17, as presented,, the measured actual pressure ratio is compared to a desired pressure ratio to be set or to a modeled actual pressure ratio. Thus, the claimed subject matter of claims 1 and 17 is not

concerned with testing whether the measured actual pressure ratio falls into a desired operating range, but rather to test whether the measured actual pressure ratio reaches a desired target value or corresponds to a value that is expected on the basis of a modeling.

One cannot establish on the basis of the results of the comparison whether the compressor performance falls into an operating range in which there is surging or choking. Instead, on the basis of the described measures it may be established whether the compression itself operates in a faulty manner -- that is, whether it is able to set a desired value or an expected value. Thus the claimed subject matter and its objective is different than the subject matter of the "Wang" reference.

In particular as to claim 2, the Office Action refers to column 6, lines 15 through 18 of the "Wang" reference, which assertedly provides that the compressor pressure ratio is compared to specified threshold values. The specified threshold values in this instance, according to the Office Action, supposedly correspond to the desired pressure ratio to be set according to the feature of claim 2. But the threshold values are, for example, the boundary lines 120 and 121 in Figure 8 or the boundary lines 105 and 106 in Figure 6. These boundary lines merely define the operating range desired for the operation of the compressor or not desired for the operation of the compressor, but, in contrast to claimed subject matter, they do not represent a desired pressure ratio that is to be set by the compressor.

In particular as to claim 3, the Office Action refers to column 6, lines 8 through 10, which assertedly provides that pressure threshold values may be calibrated as a function of the specific engine operating parameters. The cited passage deals with pressure threshold values and -- contrary to the claimed subject matter -- not with an actual pressure ratio across the compressor, let alone the modeling of such an actual pressure ratio.

Thus, in contrast to the claimed subject matter of claims 1 and 17 as presented, the system of the applied reference does not make possible a diagnosis of a faulty function of the compression, but rather is apparently only intended to establish in which operating range the compressor is working and possibly to modify the operating conditions of the internal combustion engines so that the compressor operates in a desired operating range. Thus the "Wang" reference does not identically describe (or even suggest) the features of *comparing the measured actual pressure ratio with one of a desired setpoint pressure ratio to be set and a modeled actual pressure ratio, and detecting an error as a function of a result of the comparing*, as provided for in the context of claims 1 and 17 as presented.

Accordingly, claims 1 and 17 as presented are allowable.

Claims 2 to 6, 10 to 12 and 16 depend from claim 1 as presented, and are therefore allowable for the same reasons as claim 1 as presented.

It is therefore respectfully requested that the anticipation rejections be withdrawn.

It is therefore respectfully submitted that all of claims 1 to 17 are allowable.

Conclusion

In view of the foregoing, it is believed that the objections to and the rejections of the claims have been obviated, and that claims 1 to 17 are therefore allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
KENYON & KENYON

By: Gerard A. Messina

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

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